

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the amendments above and the following comments.

Editorial amendments have been made to claim 6, hopefully, to make the structure of the pad embodiment thereof clearer. Applicants do not believe that the changes to claim 6 introduce new matter or require anything other than a cursory review by the Examiner in terms of support.

Additionally, new claims 12-15 have been added. Since these claims pertain to the "pad" embodiment, which was elected, Applicants respectfully submit that these new claims are drawn to the elected subject matter.

Applicants also respectfully submit that these new claims do not introduce new matter. Claim 12 is supported by, for example, Figures 1-3. Claim 13 is supported by, for example, Figure 1. Claim 14 is supported by, for example, Figure 2. Claim 15 is supported by the sentence bridging pages 29-30 read in conjunction with the data in Table 1 on page 34.

Claims 1, 2, 6, 8, 9 and 11 were rejected under 35 USC § 102(b) as being anticipated by JP 10-025460 (hereinafter "the Japanese publication") as allegedly evidenced by Applicants' admission. In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

Applicants previously argued that the Japanese publication did not teach the glass transition temperatures and immiscibility requirements of the rejected claims. The Examiner counters that "they are deemed to be inherent properties of the same chemistry of the claimed

USSN 10/537,469
Amendment under 37 CFR § 1.116 filed on September 17, 2008

invention.” However, Applicants respectfully submit that it is well-known that the fact that two polymers are made from the same types of monomers or comonomers does not mean that the polymers will possess the same properties. Differences in amounts of respective monomers, ratios of monomers, positions of the monomers within the polymer, and polymerization method, among other things, all establish the resultant properties of the respective polymers. Identical properties cannot be presumed unless all result-effective variables are identical and the Examiner has not here established that this is the case.

Indeed, it is also well-established, particularly with respect to polymers, that chemical make-up, in terms of monomers used, is inadequate alone to determine properties. In such cases, the invention may be properly defined in terms of properties and anticipation requires that it be shown that the prior art possessed such properties. *See, for example, E. I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 7 USPQ2d 1129, 1133 (Fed. Cir. 1988) (“On occasion, particularly with polymers, structure alone may be inadequate to define the invention, making it appropriate to define the invention in part by property limitations.”) *See, also, id.* at 1134 (“The issue is whether the claimed copolymer, *as defined in part by various property parameters*, is new. * * * Phillips must prove on remand that *the strength limitations* of claims 1 and 12 *are possessed* by the Witt and Leatherman products (emphasis added).)”

Respectfully, the Examiner has not advanced any good reason to believe that the adhesive of the Japanese publication is identical to that instantly claimed. The Examiner points to the fact that the respective polymers may be made from the same monomers, but, as discussed above, this is insufficient to make even a colorable case of identical properties. In point of fact, the available evidence suggests that the respective adhesives are not identical and possess different properties.

USSN 10/537,469

8

Amendment under 37 CFR § 1.116 filed on September 17, 2008

Thus, the Japanese publication quite clearly states that the adhesive described therein is a *strong* adhesive, which would, therefore, exhibit a *strong* bond strength. See, numbered paragraph [0010]. In contrast, the instant adhesives are characterized by a *low or weak* bond strength. See, for example, page 3, lines 26-29.

In view of the foregoing, Applicants respectfully submit that none of the claims are properly rejected as anticipated by the Japanese publication. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection as to all of the claims.

Applicants also respectfully request that the Examiner give special consideration to claim 6 and new claims 12-14. These claims provide further limitations as to the structure of the adhesive pad article. According to the Examiner, these structural limitations represent "statements of intended use" that do not serve to distinguish structure over the prior art. Applicants respectfully disagree. Claim 6 quite clearly requires a structural relationship between the sheets, wherein at least two of the sheets are required to lay one on top of the other. This is not a statement of intended use, but, rather, a structural arrangement of these two sheets within the claimed adhesive pad article. The Examiner is simply wrong in ignoring these limitations and admittedly ignoring them.

The Examiner's citation of *In re Pearson*, 181 USPQ 641, 644 (CCPA 1974), does not support the Examiner's position. In that case, the claims were drawn to a composition that applicant therein admitted was identical to a composition in the prior art. Applicant attempted to distinguish his composition from the prior art on the ground that the prior art composition had been used as an insecticide, whereas applicant intended his claimed composition to be used "for

reducing pops and unsound kernels in peanut plants.” The court held that such statement of intended use did not change the fact that the claimed composition was the same as the prior art composition and, therefore, was not novel.

This is altogether different from the situation involved here. Claim 6 does not recite an intended use, but, instead, the structural limitations that the claimed article comprises a plurality of sheets, at least two of which lie one on top of the other.

Respectfully, the Examiner’s is clearly wrong in characterizing these structural limitations of claim 6 as statements of intended use and in, thereafter, ignoring these structural limitations. In view of the foregoing, Applicants respectfully request that this rejection be withdrawn as to claim 6 and not be made against claims 12-14, even if the rejection is maintained for some reason against the other rejected claims.

Claims 4, 5 and 10 were rejected under 35 USC § 103(a) as being obvious in view of the Japanese publication. In response, Applicants submit that this rejection is in error and respectfully request that the Examiner reconsider and withdraw this rejection as well. This rejection is premised on the Japanese publication anticipating the broader aspects of the present invention, which Applicants have explained above is not, in fact, the case. The Examiner takes official notice that primers and release coatings are well-known in the art. Applicants respectfully submit that even if this is true, this still does not overcome the failure of the Japanese patent to teach the glass transition temperatures and immiscibility requirements incorporated by reference into the rejected claims. Consequently, this rejection is also in error and, therefore, Applicants respectfully request that the Examiner reconsider and withdraw it as well.

USSN 10/537,469
Amendment under 37 CFR § 1.116 filed on September 17, 2008

10

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
NORRIS MCLAUGHLIN & MARCUS, P.A.

By /Kurt G. Briscoe/
Kurt G. Briscoe
Attorney for Applicant(s)
Reg. No. 33,141
875 Third Avenue
18TH Floor
New York, New York 10022
Phone: (212) 808-0700
Fax: (212) 808-0844

USSN 10/537,469
Amendment under 37 CFR § 1.116 filed on September 17, 2008

11